

Application No. 10/647,9033
Amendment dated September 15, 2005
Reply to Office Action of June 2, 2005

REMARKS

Applicant amended claims 1 and 6, and added new claims 15 and 16 to further define Applicant's claimed invention. The amendment to claim 1 is supported at least by the specification on page 10, lines 4 and 13-15; and Fig. 8. New claims 15 and 16 are supported at least by Fig. 8.

In the Office Action, the Examiner rejected claims 1-6 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,962,747 to Biller ("Biller"). Applicant respectfully traverses the Examiner's rejection. Independent claim 1, as now amended, recites a stapler including a body with a staple storage compartment and "a mechanism for ejecting staples from said staple storage compartment." Biller teaches a spear gun having a grip housing 12 with an elongated slot 38 adapted to receive trigger assembly 14. The Examiner contends that elongated slot 38 is "capable of holding a stack of staples." (Office Action, page 2, paragraph 3). Applicant respectfully disagrees with the Examiner's contention. Elongated slot 38 is adapted to receive trigger assembly 14, not a stack of staples. (See Biller, col. 3, lines 14-15; Fig. 3). Even if slot 38 were adapted to receive staples, trigger assembly 14 would not be insertable into slot 38 because of the presence of the staples. Accordingly, Applicant respectfully submits that Biller does not teach or suggest a stapler with a stapler storage compartment and a mechanism for ejecting staples from the staple storage compartment as recited in independent claim 1 of Applicant's claimed invention. Applicant submits that the rejection of claims 1-6 and 11 under 35 U.S.C. § 102(e) as being anticipated by Biller has been overcome.

The Examiner rejected claims 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Biller in view of U.S. Patent No. 4,777,948 to Wright ("Wright"). Applicant traverses the Examiner's rejection. Biller is directed to a spear gun. (Biller, Abstract, line 1). Wright is directed to a surgical ronguer. (Wright, col. 1, line 65). According to the MPEP, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor

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or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (MPEP § 2141.01(a), "To Rely On A Reference under 35 U.S.C. 103, It Must Be Analogous Prior Art," page 2100-99, col. 1 (May 2004), quoting *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) ("[t]he court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look, to fasteners for garments;" see MPEP 2141.01(a), "Analogy In The Mechanical Arts," page 2100-100, col. 1 (May 2004)). Neither Biller nor Wright are directed to staplers, or are concerned with handle design problems of staplers. Accordingly, Applicant submits that Biller and Wright are non-analogous art and cannot be relied upon to support the Examiner's rejection. Applicant submits that the rejection of claims 7-10 under 35 U.S.C. § 103(a) has been overcome.

The Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,848,637 to Pruitt ("Pruitt") in view of Biller and Wright. Applicant respectfully traverses the Examiner's rejection. Independent claim 12 recites a method for grasping a stapler by "placing the handle of the stapler in the palm of the user's hand with the thenar eminence of the palm in contact with the concave thenar fitting handle; placing the dorsum of the user's hand in contact with the bottom surface of the proximal extension; positioning the index finger and the thumb opposing one another along the body of the stapler; and placing the three remaining fingers of the user's hand around the handle of the stapler."

Pruitt teaches a stapler 14 having a handle 15. (Pruitt, col. 7, lines 23-43; Figs. 14-15). Applicant submits that the combination of Pruitt, Biller, and Wright cannot be maintained because as set forth above, Biller and Wright are non-analogous art. Applicant submits that a person of ordinary skill would not look to a disclosure concerning spear guns (Biller) or ronguers (Wright) in order to modify the stapler of Pruitt.

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Moreover, even if Pruitt were modified as suggested by the Examiner, the combination of Pruitt, Biller, and Wright still would not yield Applicant's claimed invention because none of the references, whether alone or in proper combination, teach or suggest a method for gripping a stapler handle as recited in independent claim 12 of Applicant's claimed invention. The Examiner contends that "[i]t would have been obvious to modify Pruitt with indentation for more comfortable ergonomic fitting to a surgeon's hand." (Office Action, page 3, paragraph 4). The Examiner's statement does not indicate how the combination teaches or suggests the steps of Applicant's claimed method, for example only, the step of "positioning the index finger and the thumb opposing one another along the body of the stapler." Applicant submits that the rejection of claim 12 under 35 U.S.C. § 103(a) has been overcome. Applicant submits that the rejection over claims 13 and 14 is rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

Applicant submits that independent claims 1 and 12 are patentable and that dependent claims 2-11, 13-16 dependent from independent claims 1 or 12, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including

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any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

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